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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,877	07/15/2003	Eric N. Paton	039153-0642 (H0970)	7818

26371 7590 12/28/2004

FOLEY & LARDNER  
777 EAST WISCONSIN AVENUE  
SUITE 3800  
MILWAUKEE, WI 53202-5308

EXAMINER
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NOVACEK, CHRISTY L

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 10/619,877	<b>Applicant(s)</b> PATON ET AL.	
	<b>Examiner</b> Christy L. Novacek	<b>Art Unit</b> 2822	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

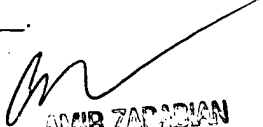
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
 AMIR ZAFARIAN  
 ELITE PATENT & INVENTOR  
 TECHNOLOGY CENTER 2801

*Advisory Action*

This office action is in response to the proposed amendment filed November 22, 2004.

*Response to Amendment*

The declaration filed on November 22, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Zheng et al. (US 6,762,085) reference. The evidence is sufficient to establish a conception of the invention prior to the effective filing date of the Zheng reference. However, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Zheng reference to either a constructive reduction to practice or an actual reduction to practice. Furthermore, the evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country either before or after the effective date of the Zheng reference. Rule 37 CFR 1.131 requires that in order to establish invention of the claimed subject matter prior to the effective date of a reference, the affidavit or declaration must show "reduction to practice prior to the effective date of the reference, **or** conception of the invention prior to the effective date of the reference **coupled with** due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." Applicant's declaration filed under 37 CFR 1.131 does not establish an actual reduction to practice, nor diligence from a date prior to the reference date to a subsequent (actual) reduction to practice, nor diligence from a date prior to the reference date to the filing date of the application (constructive reduction to practice). It is to be noted that the declaration does not even claim to show evidence of reduction to practice or diligence. The declaration only claims to show conception of the invention, which is not enough, in and of itself, to establish prior invention. Therefore, the rejections of claims 1-4, 7-10 and 17-

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20 as being unpatentable over Zheng et al. in view of Chu et al. (US 6,649,492) are maintained.

The proposed amendments to the claims will not be entered because they raise new issues which would require further search and/or consideration and because they present additional claims without canceling a corresponding number of finally rejected claims.

### ***Response to Arguments***

The arguments filed on November 22, 2004 are moot in view of the proposed amendment not being entered.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy L. Novacek whose telephone number is (571) 272-1839. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on (571) 272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLN  
December 22, 2004

  
AMIR ZARABIAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800